

REMARKS

Claims 1-8, 10-11, and 13-21 are pending in the present application. The specification has been amended to properly state the amount of the UVI-6974 in Example 6. Support for this amendment can be found in the specification at page 27, lines 2-3. Newly added claim 21 is supported in the specification, in Table 1 at page 26, line 6. No new matter has been added. Reconsideration of the present application in view of the following remarks is respectfully requested.

**1. The Rejection of Claims 1-5, 10-11, 13, 15-16 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Melisaris in view of Tsao**

Claims 1-5, 10-11, 13, 15-16 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Melisaris (WO 99/50711) in view of Tsao (U.S. Patent No. 4,156,035).

Applicants respectfully traverse the rejection.

Applicants herewith submit two Declarations under 37 C.F.R. §1.131 to swear behind the primary reference, Melisaris. The effective date of the Melisaris reference, i.e., the date on which the reference is available as prior art, is October 7, 1999. As shown from the two declarations submitted herewith, Applicants conceived the liquid, radiation-curable composition of claim 1 prior to October 7, 1999 and, together with due diligence from prior to October 7, 1999, Applicants subsequently reduced it to practice.

Conception of the present invention prior to October 7, 1999 is established by the May 15, 2003 Declaration of Richard Leyden. As stated therein, in August and early September of 1999, Dr. Leyden engaged in a series of conversations with Dr. Ranjana Patel, a co-inventor, regarding the desirability of making a liquid, radiation-curable composition as defined by claim 1. Dr. Leyden communicated the conception to Frank Tran on or about September 8 or 9, 1999,

well before the critical date of October 7, 1999 (Leyden Declaration, paragraph 5; Tran Declaration, paragraph 3).

Reduction to practice of a composition falling within the scope of claim 1 is established by the Declaration of Frank Tran. On September 10, 1999, Mr. Tran began the project that culminated in reduction to practice of the subject of claim 1 (Tran Declaration, paragraph 5). The origination date of the project is supported by the date at the top of his notebook page 39 (Tran Declaration, Exhibit 1, page 2) and in the upper right-hand corner of the corresponding spreadsheet (Tran Declaration, Exhibit 2).

In the initial phase of the project, Mr. Tran formulated six compositions known as the S179-39A through F series (Tran Declaration, paragraph 4). In that series, compositions S179A through F correspond to Examples 3 through 8 in the specification of the above-identified patent application (Compare Tran Declaration, Exhibit 2 to Table 1 on page 26 in the instant specification). Compositions S179-39E and F represent the invention of claim 1.

From September 10 through October 18, 1999, Mr. Tran measured and recorded the photospeed and green strength of specimens built from the compositions of series S179-39A through F (Tran Declaration, paragraphs 7 and 8 and Exhibits 1-3). The photospeed and green strength measurements for S179E and F established that the composition defined by claim 1 would work for its intended purpose (Leyden Declaration, paragraph 6; Tran Declaration, paragraph 11).

Due diligence from prior to October 7, 1999 until the subsequent reduction to practice of the above-identified invention is established by the work accomplished by Mr. Tran in the brief period of time from September 10 to October 18, 1999. According to MPEP § 2138.06 and Emery v. Ronden, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974), reasonable diligence does not

require that the inventor drop all other work to concentrate on the particular invention involved. From September 10 to October 18, 1999, Mr. Tran was working on three major projects in the lab, and had to prioritize and divide his time according to the demands of all those projects (Tran Declaration, paragraph 12).

In composition 39F, Mr. Tran decided to add additional cationic photoinitiator to the composition to improve the mechanical properties of the articles produced therefrom. Since this inventive contribution is now being claimed in the present invention as newly added claim 21, Mr. Tran is being added as an inventor/applicant of the present application. An Amendment under 37 C.F.R. § 1.48(c) is filed herewith.

Applicants respectfully submit that the two declarations submitted herewith are sufficient to overcome the Melisaris reference. According to MPEP § 715, a Declaration under 37 C.F.R. § 1.131 that is sufficient to swear behind a reference overcomes the outstanding rejection. Applicants respectfully submit that the rejection should be withdrawn.

**CONCLUSION**

Applicants believe that the present application is now in condition for allowance.

Favorable consideration of the application is respectfully requested.

The Commissioner is authorized to charge any fee due, or credit any overcharge as a result of this Supplemental Response to Deposit Account No. 16-2500.

Respectfully submitted,

Proskauer Rose LLP

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By

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